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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,888	04/06/2001	Hisashi Hotta	003510-091	3377

7590

11/21/2005

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,888

Applicant(s)

HOTTA, HISASHI

Examiner

Cynthia Hamilton

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/20/05, 09/27/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 10-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 2-5, 10-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claim 1 is allowed.
2. Claims 2-5, 10-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The removal of "after developing process" from the limit to contact angle of a non-image area of the anodic oxidation coating in instant claim 2 leaves unclear whether the now claimed printing plate of claims 2-5, 10-21 is supported by the original disclosure. The original claim 2 is as follows:

Art Unit: 1752

2. A planographic printing plate comprising a recording layer writable by exposure to an infrared laser, said recording layer provided on a support, the support including an aluminum substrate comprising a roughened surface including an anodic oxidation coating disposed thereon, and the anodic oxidation coating being at least one of:

(i) density from 1000 kg/m³ to 3200 kg/m³, or

(ii) micropores exposed on the surface of anodic oxidation coating including diameters of not more than 15 nm, and a contact angle of a non-image area after a developing process is not more than 20°, the micropores including a vacancy ratio of in percent as follows:

vacancy ratio = $(1 - (\text{density of anodic oxide coating} / 3.98)) \times 100$

wherein density of anodic oxidation coating (g/cm³) = weight of anodic oxidation coating per unit area/thickness of

the anodic oxide coating and the vacancy ratio is from 20% to 70%.

Claim 2 is now as follows:

Claim 2. (Currently Amended) A planographic printing plate comprising a recording layer writable by exposure to an infrared laser, said recording layer provided on a support, the support including an aluminum substrate comprising a roughened surface including an anodic oxidation coating disposed thereon, the anodic oxidation coating before said recording layer is provided thereon having at least one of:

- (i) density from 1.0 g/cm³ to 3.2 g/cm³ determined immediately after said anodic oxidation coating is disposed on the substrate, and
- (ii) a vacancy ratio from 20% to 70%, and micropores physically exposed on the surface of the anodic oxidation coating having diameters of not more than 15 nm,

Application No. 09/826,888
 Attorney's Docket No. 003510-091
 Page 3

wherein a contact angle of a non-image area of the anodic oxidation coating is not more than 20°,

and wherein the vacancy ratio in percent and the density of the anodic oxidation coating before said recording layer is provided are respectively as follows:

vacancy ratio = $(1 - (\text{density of anodic oxide coating} / 3.98)) \times 100$

density of anodic oxidation coating (g/cm³) = weight of anodic oxidation coating per unit area/thickness of the anodic oxide coating, and wherein the recording layer comprises a thermal type photosensitive layer directly writable by exposure to an infrared laser, the thermal type photosensitive layer including infrared absorbing agent(s) and polymer(s) insoluble in water and soluble in alkaline water, with the solubility of an exposed portion of the thermal type photosensitive layer changing with respect to an alkali developer.

Art Unit: 1752

Applicants have “noted” that the defined contact angle of the anodic oxidation coating after a development process is the same as that before the recording layer is provided thereon so that the amendment of claim 2 should remove any perceived indefiniteness with respect to the claim.

Applicants have not pointed out where evidence in the original disclosure supports this “noted” equivalence. Applicant has not presented sufficient evidence to support their allegation that the contact angle of the anodic oxidation coating after a development process is the same as that before the recording layer is provided thereon. Thus, applicants have failed to show sufficient support in the original disclosure to make clear a worker of ordinary skill in the art would have understood this to be so disclosed in the originally disclosed specification and claims. See particularly MPEP 2163.04.

3. The Declaration of Hisashi Hotta under 37 CFR 1.132 filed June 20, 2005 is insufficient to overcome the rejection of claims 1 - based upon 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement as set forth in the last Office action because: Applicant Hisashi Hotta declares the following as the only evidence for support of applicant's arguments:

I declare that a development process used in the invention does not include particular surface modification processes and thus the contact angle of the surface of the anodic oxidation coating before the recording layer is formed thereon is not different from that after development.

No other evidence is given to support this declaration. Applicants present no tests, no limitation on the kind of development. At best, this is the opinion of an expert. Even then, the

Art Unit: 1752

expert is the applicant serving his own purposes. The lack of clarification as to how one of ordinary skill would understand that the surface was the same before coating with recording layer and after development with respect to non-image areas and contact angle remains. The rejection is not overcome.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

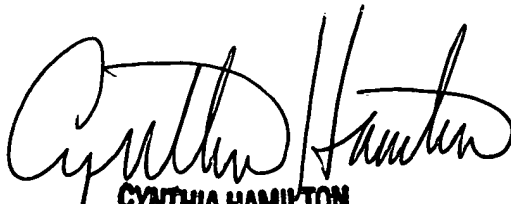
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331.

The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1752

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CYNTHIA HAMILTON
PRIMARY EXAMINER

November 16, 2005

Cynthia Hamilton
Primary Examiner
Art Unit 1752